

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

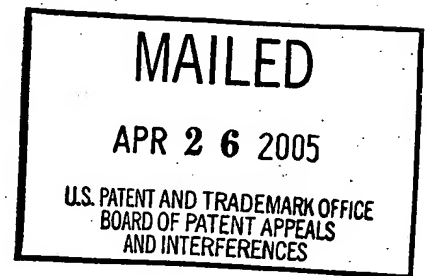
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MANABU HASEGAWA

Appeal No. 2005-0570
Application No. 10/049,294

HEARD: APRIL 7, 2005



Before FRANKFORT, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 and 11. Claims 1-9, the only other claims pending in this application, stand allowed.

We REVERSE.

BACKGROUND

The appellant's invention relates to a card attachment/detachment device for holding detachably a subscriber identification module or SIM card for a cordless

telephone (specification, page 1). Further understanding of the invention can be obtained from claim 10, which reads as follows:

10. A card attachment and detachment device holding detachably a card in a space defined between a body and a bottom plate, comprising:
- a holder for being inserted into and removed from the space and having a card accommodation section accommodating the card;
 - a lock member for holding the holder within the space;
 - a release member for releasing the lock of the lock member; and
 - a biasing member for ejecting the holder when the card is removed from the card accommodation section.

The Prior Art

The examiner relied upon the following prior art reference of record in rejecting the appealed claims:

Kubo	2326050	December 9, 1998
(UK patent application)		

The Rejection

Claims 10 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kubo.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (mailed January 14, 2004) for the examiner's complete reasoning in support of the

rejection and to the brief (filed November 3, 2003) and reply brief (filed March 15, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied Kubo reference, and to the respective positions articulated by the appellant and the examiner. For the reasons which follow, we cannot sustain the examiner's rejection.

Kubo discloses a card holder 52 having a card accommodation portion 52a provided to the lower surface side, a front panel portion 52b and a cantilever plate spring 52c provided to the upper surface side. The cantilever plate spring 52c is integrally formed when molding the card holder 52 and has a root portion 52c-1, an engagement claw 52c-2 and a handle portion 52c-3 located at the end thereof. The engagement claw 52c-2 has a slant surface 52c-2a and a vertical surface 52c-2b. The handle portion 52c-3 has a recess portion 52c-3a on the upper surface which makes it possible for the end of the forefinger of a hand of the operator to be easily engaged with the handle 52c-3. To remove the card holder 52 from the housing, the battery pack is first detached from the portable telephone set 30. Next,

[a]s shown in Fig. 9, a forefinger 70 is inserted into the finger insertion recess portion 45b-2. Then, as indicated by an arrow 71, the handle portion 52c-3 is pressed in the direction Z2, and is thereafter drawn in the direction Y2 [as indicated] by an arrow 72. In the operation of pressing the handle portion 52c-3 in the direction Z2, as shown in Fig. 7D, the cantilever plate spring 52c is bent in the direction Z2, and the engagement claw 52c-2 is disengaged from the central

counter U-shaped frame portion 51a-4a. Hence, the card holder 52 is released from the locked state in which it is locked to the housing 51. The forefinger 70 strongly engages with the recess portion 52c-3a of the handle portion 52c-3. In the subsequent operation, the claw portion 52c-2 passes below the frame portion 51a-4a, so that the card holder 52 is drawn to the outside of the housing 51 [page 16].

Appellant argues that Kubo lacks a "biasing member for ejecting the holder when the card is removed from the card accommodation section" and thus does not anticipate¹ claim 10. The examiner contends that the slant surface 52c-2a of the engagement claw 52c-3 responds to the biasing member limitation. According to the examiner,

[t]he limitation, "for ejecting the holder when the card is removed from the card accommodation section," is a recitation of intended use, and has only been given patentable weight to the extent that the prior art structure must be capable of performing this function to meet the limitation. In this case, biasing member 52c-2a, as seen in Fig. 7E, is capable of aiding in the ejecting the holder, since the slanted shape of the feature will force the holder to eject, e.g. when the user releases the lock member in the position seen in Fig. 7E. Therefore, this limitation is anticipated by Kubo [answer, page 4].

¹ Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984) cert. dismissed, 468 U.S. 1228 (1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Even assuming that the limitation "for ejecting the holder when the card is removed from the card accommodation section" is merely a recitation of intended use,² the examiner's determination that Kubo's slant surface 52c-2a has this capability, i.e., that the slanted shape of this feature will force the holder to eject if a user releases the handle portion 52c-3 in the position shown in Fig. 7E, is speculative (see pages 2 and 3 of the reply brief) and unsubstantiated by any evidence in this case. It is equally probable that any upward force of the engagement claw 52c-2 on the frame portion 51a-4a would be insufficient to overcome the various frictional forces present between the holder 52 and the housing 51, as suggested by the appellant on pages 4-5 of the brief.

Under principles of inherency, when a reference is silent about an asserted inherent characteristic, as Kubo is in this case, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgird v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that

² The position of the examiner in this regard is not challenged by the appellant and appears reasonable on its face to us.

the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

For the foregoing reasons, we cannot conclude that Kubo's slant surface 52c-2a meets the limitation "a biasing member for ejecting the holder when the card is removed from the card accommodation section" of claim 10. We thus cannot sustain the rejection of claim 10 or claim 11 which depends therefrom.

CONCLUSION

To summarize, the decision of the examiner to reject claims 10 and 11 under 35 U.S.C. § 102(b) is reversed.

REVERSED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge


JEFFREY V. NASE

JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR

JENNIFER D. BAHR
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

JDB/dpv

Appeal No. 2005-0570
Application No. 10/049,294

Page 8

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314